

REMARKS

In view of the following remarks, the Examiner is requested to allow claims 1-13, 17-19, 34, 49, 50, 56, 57, 59-65, and 66-70, the only claims pending and under examination in this application.

Formal Matters

Claims 2-13, 17-19, 34, and 60-62 have been amended for clarity as requested by the Examiner during the interview held December 10, 2007 (i.e., to replace the word "A" with "The" to emphasize that they are dependent claims).

Claims 13, 17-19 and 64 have been amended to recite positive method steps as requested by the Examiner during the interview held December 10, 2007.

Claims 1 and 59 have been amended to further define "test request." Support for this amendment is found on page 9, line 13.

As no new matter has been added by way of this amendment, entry thereof by the Office is respectfully requested.

Interview Summary

Applicants wish to thank Examiner Lin for extending the courtesy of a personal interview to Applicants' representative, David Scherer, on December 10, 2007. During the interview, the rejections over Kaushikkar, Podyminogen and Sandstrom were discussed. With regard to the 102 rejection over Kaushikkar, the definition of a test request as claimed and as assertedly taught in Kaushikkar was discussed. With regard to the 103 rejection over Kaushikkar and Podyminogen, the Examiner noted that certain dependent claims (e.g., Claim 17) should recite active method steps to receive appropriate consideration of the limitations. The requirements for claims directed to computer program products (Claims 56, 57 and 63) were also discussed.

Claim Rejections - 35 U.S.C. § 102

Claims 1-13, 49, 50, 56, 57, 59-63, 65, and 68-70 have been rejected under 35 U.S.C. § 102(b) as allegedly being anticipated by Kaushikkar (US 2002/0024026 A1). The Applicants respectfully traverse this rejection.

The standard for anticipation under section 102 is one of strict identity. An anticipation rejection requires a showing that each limitation of a claim be found in a single reference, *Atlas Powder Co. v. E.I. DuPont de Nemours & Co.*, 224 U.S.P.Q. 409, 411 (Fed. Cir. 1984). Further, an anticipatory reference must be enabling, see *Akzo N.V. v. United States Int'l Trade Comm'n* 808 F.2d 1471, 1479, 1 U.S.P.Q.2d 1241, 1245 (Fed. Cir. 1986), *cert denied*, 482 U.S. 909 (1987), so as to place one of ordinary skill in possession of the claimed invention. Thus, legal anticipation requires that a single prior art reference expressly or inherently discloses each and every limitation of a challenged claim. *Glaxo v. Novopharm, Ltd.* 334 U.S. P.Q.2d 1565 (Fed. Cir. 1995).

The claimed invention of the subject application is directed to a method including the steps of receiving a test request that uses a sub-array of a chemical, retrieving a pattern of locations of features that make up the sub-array using the test request, exposing the array to a sample, and reading the sub-array. As amended, the claims specify that the test request is one that references a type of test to be performed (see independent Claims 1 and 59).

In making this rejection, the Examiner asserts that Kaushikkar teaches a method that includes receiving a test request as is claimed and that the memory carries different patterns based on the test request. To support this rejection, the Examiner cites page 6, paragraphs 59-61.

However, the Applicants submit that the "test request" of Kaushikkar is specifically based location data of the features of the array (e.g., providing information about the location of a subset of features on an array for sample contacting and scanning). Nowhere in the passages cited by the Examiner (nor elsewhere in the reference) does Kaushikkar teach that a test request that uses a sub-array of a chemical array is one that references a type of test to be performed.

Therefore, because Kaushikkar fails to teach each and every element of the claimed invention, Claims 1-13, 34, 49, 50, 56, 57, 59-63, 65, and 68-70 are not anticipated. The Applicants thus respectfully request that and this rejection be withdrawn.

Claim Rejections - 35 U.S.C. § 103

Claims 17-19 have been rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Kaushikkar in view of Podyminogin et al., (Nucleic Acids Research (2001) 29(24):5090-5098).

In order to meet its burden in establishing a rejection under 35 U.S.C. § 103 the Office must first demonstrate that the combined prior art references teach or suggest all the claimed limitations. See, for example:

- *Pharmastem Therapeutics v. Viacell et al.*, 2007 U.S. App. LEXIS 16245 (Fed. Cir. 2007) which states that "the burden falls on the patent challenger to show by clear and convincing evidence that a person of ordinary skill in the art would have had reason to attempt to make [every element of] the composition or device, or carry out the [entire] claimed process, and would have had a reasonable expectation of success in doing so," (citing *KSR Int'l Co. v. Teleflex Inc.*, 127 S. Ct. 1727, 1740 (2007));
- *Omegaflex, Inc. v. Parker-Hannifin Corp.*, 2007 U.S. App. LEXIS 14308 (Fed. Cir. 2007) which states that "[t]he Supreme Court recently explained that 'a patent composed of several elements is not proved obvious merely by demonstrating that each of its elements was, independently, known in the prior art,'" (citing *KSR Int'l Co.* at 1741); and
- *Dystar Textilfarben GmbH v. C.H. Patrick Co.*, 464 F.3d 1356, 1360 (Fed. Cir. 2006) which states that "[once] all claim limitations are found in a number of prior art references, the factfinder must determine '[w]hat the prior art teaches, whether it teaches away from the claimed invention, and whether it motivates a combination of teachings from different references,'" (citing *In re Fulton*, 391 F.3d 1195, 1199-1200 (Fed. Cir. 2004)).

The Applicants note that Claim 13 (from which Claim 17 depends) and Claims 17-19 have been amended to recite active method steps as requested by the Examiner in the interview of December 10, 2007.

In making this rejection, the Examiner asserts that Kaushikkar's disclosure of a system specifying scanning array area based on feature location data in combination with Podyminogin's disclosure of DNA damage renders the claims obvious. The Examiner asserts that in paragraphs [0016] and [0017], Kaushikkar teaches feature locations outside the retrieved subarray pattern do not have signal data.

First, as discussed in the previous section, the Applicants submit that Kaushikkar fails to teach a test request as claimed (i.e., a test request for a sub-array of a chemical array that references a type of test to be performed). As Podyminogin is cited merely for its asserted teaching of damaging probes, it fails to remedy this fundamental deficiency in Kaushikkar.

Second, the Applicants submit that neither Kaushikkar nor Podyminogin teach damaging probes at feature locations outside any retrieved sub-array pattern to render them incapable of providing signal data representative of binding of a sample component as claimed (see Claims 13 and 17). Rather, the Applicants submit that Kaushikkar merely states that data are retrieved based on accessed location data (i.e., the location data input by the user) and that there is a "scan-area controller that controls scanning... based... on the accessed location data." Therefore, Kaushikkar merely teaches one not to scan areas that fall outside the identified area (i.e., the area identified using location data). Kaushikkar does not teach damaging the probes in the features outside the sub array as is claimed. Podyminogin also fails to teach this element of the claimed invention.

Further more, the Applicants submit that the cited references, in failing to teach either 1) a test request for a sub-array of a chemical array that references a type of test to be performed, or 2) damaging probes at feature locations outside any retrieved sub-array pattern to render them incapable of providing signal data representative of binding of a sample component, likewise fail to suggest these elements of the claimed

invention. Indeed, given that Kaushikkar's teaching is drawn to restricting the scan area based on the location data provided by the user, there is simply no suggestion or motivation for one of skill in the art to damage the features outside the sub array area as is claimed.

Thus, the Applicants submit that because the cited references fail to teach or suggest at least 2 elements of the claimed invention of Claims 17-19, a *prima facie* case of obviousness has not been established. Accordingly, the Applicants respectfully request that this rejection be withdrawn.

Claims 34 and 64 have been rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Kaushikkar in view of Sandstrom (2005/0079603).

In making this rejection, the Examiner asserts that Kaushikkar's teaching of a system specifying scanning array area based on location data in combination with Sandstrom's spatial light modulator (i.e., for masking a microarray) renders the claims obvious.

As discussed in the previous sections, the Applicants submit that Kaushikkar fails to teach or suggest a test request as claimed (i.e., a test request for a sub-array of a chemical array that references a type of test to be performed). As Sandstrom is cited merely for its asserted teaching of masking a microarray, it fails to remedy this fundamental deficiency in Kaushikkar.

Accordingly, the Applicants respectfully request that this rejection be withdrawn.

Computer Program Products

As noted above in the *Interview Summary* section, the claimed computer program products of Claims 56, 57 and 63 were discussed. Applicants note that, as described in the specification on page 14, lines 25-27, computer program products are described as tangible products carrying a computer program (e.g., a memory). Page 8, lines 12-18, provides exemplary "memory" components, which includes magnetic, optical, and solid state storage devices (e.g., floppy disks, hard disks, CDs, DVDs, etc.).

Given that the specification clearly describes computer program products as tangible products, the Applicants submit that Claims 56, 57 and 63 are drawn to statutory subject matter under 35 U.S.C. § 101.

CONCLUSION

Applicants submit that all of the claims are in condition for allowance, which action is requested. If the Examiner finds that a telephone conference would expedite the prosecution of this application, please telephone Bret Field at (650) 327-3400.

The Commissioner is hereby authorized to charge any underpayment of fees associated with this communication, including any necessary fees for extensions of time, or credit any overpayment to Deposit Account No. 50-1078, order number 10021296-1.

Respectfully submitted,

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